



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P. O. Box 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

Patent Documentation Center
Xerox Corporation
Xerox Square 20th Floor
100 Clinton Ave. S.
Rochester NY 14644

COPY MAILED

JAN 07 2004

OFFICE OF PETITIONS

In re Application of :
William C. Emerson, Andrew T. Martin, :
Ruediger W. Knodt, Thomas J. Perry, Karen :
Totten, Joseph E. Miska, Keith S. Watson, :
Gary M. Davis, John F. Whiting, and Kelly J. :
Breuer :
Application No. 10/601,223 :
Filed: June 20, 2003 :
Attorney Docket No. D/A0623 :
Title: AUTOMATIC TAB DISPLAYING :
AND MAXIMUM TAB STORING USER :
INTERFACE AND A REPROGRAPHIC :
MACHINE HAVING SAME :

DECISION ON PETITION
UNDER 37 C.F.R. §1.47(b)

This is in response to the petition under 37 CFR §1.47(b)¹, filed August 28, 2003.

The above-identified application was filed on May 22, 2003, without an executed oath or declaration and identifying William C. Emerson, Andrew T. Martin, Ruediger W. Knodt, Thomas J. Perry, Karen Totten, Joseph E. Miska, Keith S. Watson, Gary M. Davis, John F. Whiting, and Kelly J. Breuer as the joint inventors. On August 14, 2003, applicant was mailed a

1 A grantable petition under 37 CFR §1.47(b) requires:

- (1) The petition fee;
- (2) a surcharge if the petition was not filed at the time of filing of the application;
- (3) a statement of the last known address of each of the non-signing inventors;
- (4) proof that diligent efforts have been made to locate the non-signing inventor;
- (5) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (6) proof of irreparable damage, and;
- (7) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 CFR §1.63.

"Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted", requiring an executed oath or declaration in compliance with 37 CFR §1.63² and a surcharge for the late filing of the oath or declaration. This Notice set a two-month period for reply.

In reply, applicant filed the instant petition (and fee), and the surcharge associated with the late filing of an oath or declaration.³ Accompanying the petition was a statement from the petitioner⁴, copies of e-mails and searches conducted by the petitioner, and a copy of a letter sent to the non-signing inventor. Petitioner states that the inventor's employment agreement was included with the petition, but this document has not been located in the electronic file.

Petitioner has met requirements (1) – (3) and (6) – (7) above.

Regarding the fourth requirement above, Petitioner has not submitted adequate proof that diligent efforts have been made to locate the non-signing inventor. *As petitioner has set forth that the non-signing joint inventor cannot be found or reached, petitioner is required to establish that a diligent effort was made to locate the non-signing inventor.* Petitioner has submitted print-outs from two online searches: one from Yahoo, and one from US Search. Petitioner's efforts have been deemed to be insufficient for the four reasons below.

First, regarding the Yahoo search, the search was narrowly tailored to two specific addresses. It is plausible that since being terminated, the non-signing inventor has moved to seek employment elsewhere, possibly out of state or even out of the country, and as such, the search was too narrow to constitute a diligent search.

Secondly, regarding the US Search results, it does not appear that petitioner completed the search. Petitioner has included a copy of the initial step of the search, which yielded three (3) Kelly J. Breuers in Geneva, Minneapolis, and Denver. Only after payment is submitted, however, will US Search reveal the addresses and contact information for these "search hits." It would appear that petitioner never completed the next step (submitting payment), and as such, no useful information was obtained. As such, petitioner's efforts to locate the non-signing inventor cannot be considered to have been diligent.

Third, petitioner sets forth "*our* phone calls to the best phone information have gone to answering machines with no call-backs⁵." This statement indicates that at least two phone call were made to at least two different phone numbers. Petitioner does not indicate which locations were telephoned. Perhaps the petitioner attempted to reach the non-signing joint inventor at the two phone numbers produced from the Yahoo search? If so, this cannot constitute a diligent effort, as the partial results from the US Search indicated to the petitioner that there were no fewer than three (3) other phone numbers which needed to be contacted.

2 Joint inventor Breuer did not execute the declaration.

3 Both the petition fee and the surcharge have been charged to petitioner's Deposit Account, as authorized in the petition.

4 The statement on the first page of the petition sets forth that the co-inventor "could be reached after diligent effort." The undersigned will assume that the omission of the word "not" subsequent to "could" is a typographical error.

5 Petitioner's declaration, paragraph 12.

Finally, the use of the word "our" indicates that the telephone calls were not made by the petitioner. This is not acceptable, as the statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted.

Regarding the fifth requirement above, the copy of the employment agreement petitioner referenced in the eleventh paragraph of his declaration has not been located in the electronic file. As such, Rule 47(b) applicant has failed to prove sufficient proprietary interest in the subject matter to justify the filing of the application⁶. The declaration sets forth that the non-signing inventor used to be employed by the purported assignee. Furthermore, the assignment document has been reviewed in the PTO's Patent Application Location and Monitoring System (PALM), and the non-signing inventor's name does not appear. Based on the evidence submitted to this point, it does not appear that Xerox has any proprietary interest in joint-inventor's Brueher contribution to the invention.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The reply to this letter may be submitted by mail⁷, hand-delivery⁸, or facsimile⁹.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.



Paul Shanoski
Attorney
Office of Petitions
United States Patent and Trademark Office

⁶ See MPEP §409.03(f).

⁷ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁸ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202

⁹ (703) 872-9306.